## REMARKS/ARGUMENTS

Claims 1 – 21 are pending in the application and are presented for reconsideration and further examination in view of following remarks.

In the outstanding Office Action, claims 1, 3, 6, 8 – 11, 13, 16, and 18 – 20 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,317,729 to Mukherjee et al. (hereinafter referred to as "the Mukherjee et al. '729 patent"); and claims 2, 4, 5, 7, 12, 14, 15 and 17 were objected to as being dependent on a rejected base claim but were identified as being allowable if rewritten in independent form to include all of the features of the base claim and any intervening claims.

By this Response, Applicant has traversed the Examiner's rejections and objections. It is respectfully submitted that no new matter within the meaning of 35 U.S.C. §132 has been introduced to the present application.

### Claims Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 1, 3, 6, 8-11, 13, 16, and 18-20 as being anticipated by the Mukherjee et al. '729 patent.

### Response

**1.  The Mukherjee et al. '729 Patent Does Not Show All of the Features of the Presently Claimed Invention**

By this Response, Applicant respectfully traverses the Examiner's rejection as all of the features of the presently claimed invention are not present in the cited prior art. For a reference

to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); *MPEP* §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); *MPEP* §2131.

Independent claim 1 recites "[a] computer-implemented method for producing a multi-layer text, comprising (a) providing (21) a text; (b) selecting (23) a text segment; (c) assigning (25) a value of a text dimension to said text segment, wherein a text dimension refers to *any* desired domain *and* includes information on one related text layer; (d) repeating (27, 29) steps (b) and (c) as many times as desired," *Present Application* at claim 1, *emphasis added.*

Independent claim 6 recites "[f]or use with a multi-layer text, the multi-layer text having text segments assigned with values of text dimensions, wherein a text dimension refers to *any* desired domain *and* includes information on one related text layer; a computer-implemented method for displaying a text of interest, comprising: (a) providing (31) at least one input value, or input value range, of *at least one text dimension*; and (b) retrieving and displaying (33) text segments having assigned thereto a value that meets said input value or input value range," *Present Application* at claim 6, *emphasis added.*

Independent claim 11 recites "[a] system that includes a display unit for producing multi-layer text, comprising: (i) a selector for selecting a text segment in said text; (ii) an assignor for assigning a value of a text dimension to said text segment, wherein a text dimension refers to *any* desired domain *and* includes information on one related text layer; and (iii) a memory for storing

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the multi-layer text." *Present Application* at claim 11, *emphasis added.*

And, independent claim 16 recites "[f]or use with a multi-layer text having text segments assigned with values of text dimensions wherein a text dimension refers to *any* desired domain *and* includes information on one related text layer, a system for displaying a text of interest, comprising: i. a receiver for receiving at least one input value or input value range of *at least one text dimension*; and ii. a retriever for retrieving and displaying *text segments* having assigned thereto a value that meets said input value or input value range." *Present Application* at claim 16, *emphasis added.*

The Mukherjee et al. '729 patent discloses a method for storing time- and view-oriented versions of engineering change information. Users of the method disclosed in the Mukherjee et al. '729 patent can create versioned objects. The versioned objects, referred to in the cited reference as "item related data files," are confined to a specific type of data. The specific types of data are enumerated in the Mukherjee et al. '729 patent as a list of eleven pre-defined specific items. The Mukherjee et al. '729 patent merely suggests that there are files of item related data, which relate to various items. Thus, in each version, a corresponding item associated data, item engineering data, etc. are provided. Accordingly, it would be possible to identify the appropriate item related data (e.g. item engineering data, item associated data, etc.) that correspond to a particular version of an object. This is a conventional and well known standard version control system found in numerous applications.

In contrast to the presently claimed invention, the Mukherjee et al. '729 patent does not disclose teach or suggest that the item related data disclosed in the Mukherjee et al. '729 patent "refers to *any* desired domain" as recited in the independent claims of the present application.

Each of the item related data files, which the Examiner equates to a text dimension, is associated with a *specific* range of information rather than *any* range of information. Thus, the item related data files of the cited prior art reference are not comparable to the "text dimension" of the presently claimed invention, which can refer to *any* desired domain. As this feature is not disclosed, taught or suggested by the cited prior art, the presently claimed invention is not anticipated by the cited prior art for at least this reason.

Furthermore, the Examiner has not shown that the item related data files "include information on one related text layer," as recited in independent claims 1, 6, 11 and 16 of the present application. The Mukherjee et al. '729 patent does not show that the item related data files refer to information relating to the text layer itself; rather, the item related data files disclosed in the Mukherjee et al. '729 patent only include information relating to the data contained therein. As a text dimension that "includes information on one related text layer" is also missing from the cited prior art, the presently claimed invention is patentable over the cited prior art for at least this additional reason.

In further contrast with the presently claimed invention, the Mukherjee et al. '729 patent does not disclose, teach or suggest "a text dimension [that *both*] refers to *any* desired domain *and* includes information on one related text layer," as recited in the independent claims of the present application. Regardless of whether the Mukherjee et al. '729 patent does not disclose, teach, or suggest either of the features of the text dimension, the Mukherjee et al. '729 patent does not show that both features of the text dimension of the presently claimed invention are contained within the item related data files of the Mukherjee et al. 729 patent. Thus, for the yet additional reason that this combination of features is not disclosed, taught, or suggested in the

cited prior art, the presently claimed invention is patentable over the cited prior art.

The Examiner even admitted that the Mukherjee et al. '729 patent does not include the feature "wherein a text dimension refers to any desired domain and includes information on one related text layer," as recited in the independent claims of the present application. In the Examiner's December 12, 2003 Office Action, he admitted that the "Mukherjee does not specifically teach wherein a text dimension refers to any desired domain and includes information on one related text layer." *Paper No. 12*, at pg. 3. Thus, for this additional reason, the presently claimed invention is patentable over the Mukherjee et al. '729 patent.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejections to claims 1, 6, 11 and 16, and the rejections to the claims dependent thereon.


2.    **Piecemeal Prosecution**

Furthermore, examining this application as the Examiner has done amounts to piecemeal prosecution, which is discouraged by the U.S. PTO. *See MPEP §707.07(g)*.

Originally, in the Examiner's Office Action dated April 8, 2003, the Examiner rejected the independent claims as being anticipated by the Mukherjee et al. '729. On August 8, 2003, the Applicant filed a fully responsive reply to this Office Action. In this reply, the independent claims were amended to recite the additional feature: "*...wherein a text dimension refers to any domain and includes information on one related text layer...*" (hereinafter referred to as "the added feature").

In a following Office Action dated December 24, 2003, the Examiner rejected the independent claims as being unpatentable over the previously cited Mukherjee et al. '729 patent

in view of U.S. Patent No. 4,071,909 to Geller. In his reasoning, the Examiner repeated *verbatim* the arguments from the April 8, Office Action without referring to the specifics of the Applicant's August 8, 2003 argument, and added a new rejection directed only toward the additional feature. The Examiner asserted that the Mukherjee et al. '729 patent did not show the added feature and thus relied on the Geller '909 patent in an attempt to render the presently claimed invention obvious. In response to the Applicant's August 8, 2003 argument, the Examiner again asserted that the Applicant's arguments were moot in light of the new grounds of rejection.

In Applicant's June 22, 2004 reply, the Applicant indicated that the Examiner did not refer to the specifics of the Applicant's previous arguments in light of the Mukherjee et al. '729 patent and further provided a detailed response submitting that the Geller '909 patent does not disclose, teach, or suggest the added feature. Note that the Examiner has never referred to the substance of the Applicant's arguments traversing his view that the Mukherjee et al.'729 patent anticipates the features of the independent claims. Peculiarly, the outstanding Office Action (dated November 2004) is very similar to the first Office Action (April 2003), except that now the Examiner also asserts that the Mukherjee et al. '729 patent can now teach the added feature, whereas in the December 2003 Office Action the Examiner held that the added feature was not disclosed, taught or suggested by the Mukherjee et al. '729 patent. In the Office Action, the Examiner again ignored the specifics of the Applicant's arguments elaborating why the Mukherjee et al. '729 patent is not anticipating and stressed that Applicant's our arguments were moot in light of the new grounds of rejection.

Thus, Applicant asserts that the Examiner is waffling to and fro ostensibly with no regard

or consideration of the Applicant's arguments, thereby examining the present application

piecemeal. Applicant submits that, by this approach of raising new grounds of rejection in every

new Office Action and therefore asserting that Applicant's counter-arguments are moot and

reasserting old rejections, and consequently failing to address the Applicant's arguments

explicitly, the Examiner unduly uses his discretion and unduly prolongs the prosecution and

incurs undue additional expense for Applicant.

Accordingly, Applicant respectfully requests that the Examiner consider all arguments

submitted herewith and cease examining the application piecemeal.

## Claim Objections

The Examiner objected to claims 2, 4, 5, 7, 12, 14, 15 and 17 as being dependent on a

rejected base claim, and indicated that the claims would be allowable if rewritten in independent

form to include all of the features of the base claim and all of the features of any intervening

claims.

## Response

By this Response, the Examiner's objection is respectfully traversed. In view of the

above presented arguments, the Applicant respectfully submits that each of independent claims 1,

6, 11, and 16 are now allowable; and therefore dependent claims 2, 4, 5, 7, 12, 14, 15 and 17 are

respectfully submitted to now be allowable in their current form .

Accordingly, reconsideration and withdrawal of the objections is respectfully requested.

## CONCLUSION

In light of the foregoing, Applicant submits that the application is in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicant respectfully requests that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.
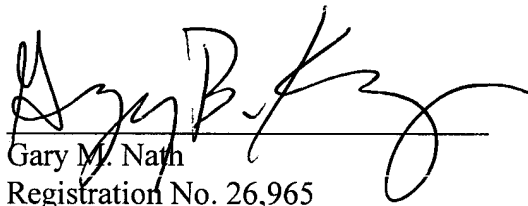
In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

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